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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,746	07/06/2001	Brian James Gingras	659/791	4594

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BRINKS HOFFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610

[REDACTED] EXAMINER

JOLLEY, KIRSTEN

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1762

8

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/900,746	GINGRAS ET AL.
	Examiner Kirsten Crockford Jolley	Art Unit 1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-62 is/are pending in the application.
  - 4a) Of the above claim(s) 49-62 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-48 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5-7</u> | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. The original numbering of the claims skipped claim number 8. Misnumbered claims 9-63 have been renumbered 8-62.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-48, drawn to a method of making wet rolls, classified in class 427, subclass 179.
  - II. Claims 49-62, drawn to an apparatus for wetting and winding a substrate, classified in class 118, subclass 500.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used with a coating material other than a wetting solution such as an adhesive or powder coating material.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Jonathan Taylor on December 9, 2002 a provisional election was made without traverse to prosecute the invention of group I, claims 1-49. Affirmation of this election must be made by applicant in replying to this Office action. Claims 49-62 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Information Disclosure Statement***

7. The information disclosure statement filed January 31, 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Japanese publications JP 2-91300, JP 5-209395, and JP 6-306793 have been placed in the application file, but the information referred to therein has not been considered, and the publications have been crossed through on the corresponding PTO-1449.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 3-7, 12-15, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Cole et al. (US 6,444,214).

Cole et al. discloses a method of making wet webs to be used as wipes. Cole et al. teaches providing a web of material, applying a wetting solution to the web, and in col. 23, lines 34-59, Cole et al. teaches that the finished wipes may be packaged in a roll, which would inherently require a step of winding the wet web into a roll. As to claim 12, Cole et al. teaches that the roll can be coreless.

Cole et al. teaches that the wipe may contain from 10-400% of the wetting composition. This range is inclusive of the ranges of claims 4-7. Cole et al. also teaches a range of from 100-300% of wetting composition on the wipe; this meets the limitation of claim 2. In col. 18, line 40 to col. 19, and col. 23, lines 16-33, Cole et al. teaches that the basesheet may be wet-formed, non-woven, and comprise a water-dispersible binder. As to claim 18, Cole et al. teaches uniformly distributing the wetting solution in the web in col. 39.

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10. Claims 1, 12, 14, 17, 31-34, and 39-40 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 01/40090 A2.

WO '090 discloses a method of making wet rolls, comprising the steps of providing a web of material, applying a wetting solution to the web to produce a wet web, and winding the wet web into rolls using a roll-forming pocket to make rolls using the apparatus illustrated in Figure 1. WO '090 teaches on page 7 that a liquid-based product which impregnates or moistens the material before forming the roll L is applied to web material N after the web material N is delivered from a perforating unit.

With respect to claims 31-33 and 39, WO '090 teaches a roll forming pocket/winding cradle comprised of three rollers 1, 3, 5 (illustrated in Figure 1) to form the rolls L or "cigarettes." In the roll forming pocket of WO '090, rollers 1, 3, and 5 each contact the wet web and each rotate in the same circular direction, whereby the second roller 3 rotates in a circular direction opposite from the direction of the movement of the wet web. WO '090 teaches that after forming roll L, the web wet roll L is separated from the web and discharged from the roll forming pocket (see page 7, lines 3-13).

As to claims 12 and 34, WO '090 teaches that preferably the roll L is coreless (page 5, lines 12-14). As to claim 14, WO '090 teaches that the may be non-woven fabric in page 3, line 13. As to claim 17, WO '090 teaches uniformly distributing the wetting solution in the web in col. 8, lines 15-16.

11. Claims 1-2, 5-7, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 256 950.

EP ‘950 discloses a method of making wet webs. EP ‘950 teaches providing a web of material, applying a wetting solution to the web, perforating the web, and packaging the continuous wet web into a roll, which would inherently require a step of winding the wet web into a roll. EP ‘950 teaches that the wipe may contain from 100-500% of the wetting composition. This range is inclusive of the ranges of claims 2 and 5-7.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-11, 16, 18-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2.

WO ‘090 is applied for the reasons discussed above in paragraph 10. With respect to claim 18, the web of material in the process of WO ‘090 is inherently provided from a source and WO ‘090 teaches perforating the web at page 7, line 4. The draw of the web is controlled via roller 1. The web is positioned adjacent wetting apparatus 7, as shown in Figure 1, and wetting solution is applied to at least one side of the web to yield a wet web. The amount of wetting solution would be determined by one skilled in the art as discussed below. With respect to claim 19, WO ‘090 does not teach that the web material is originally supplied on a roll and

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unwound. It is the Examiner's position that it would have been obvious to have supplied the web material via a wound roll because such is well known in the art in order to maintain the web material which is fed to a rolling apparatus in an orderly manner.

As to claims 2-7, 24-28, 38, and 41-46, WO '090 lacks a teaching of the add-on amount of wetting solution applied on the web in its invention. It is the Examiner's position that one having ordinary skill in the art would have been motivated to determine the optimum amount of wetting solution to be added to the substrate depending upon the desired feel and wetness of the final product and the amount that may be applied without causing the wet web to be so weak that it does not break during winding.

As to claims 8-11, 22, and 37, WO '090 lacks a teaching of the speed at which the web travels. It is the Examiner's position that the travel speed of the web is a cause-effective variable. One would have a desire to maximize the travel speed in order to increase productivity and efficiency of the process, however the travel speed must not be too fast that it causes the wet web to break during rolling. It is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art.

*In re Boesch*, 205 USPQ 215 (CCPA 1980).

As to claims 16, 30, 36, and 48, WO '090 lacks a teaching that the method of its invention is performed in an environment that is substantially free of contamination. However, the Examiner notes that WO '090 is concerned with making hygienic products comprising disinfectants or detergents as taught on page 1. It would have been obvious for one having ordinary skill in the art to have performed the process of WO '090 in a contaminant-free

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environment in order to ensure that the products remain sterile and free of germs and/or bacteria that would negate their utility.

With respect to claims 23 and 47, WO '090 teaches that the wetting solution may comprise detergents. It is well known in the art that detergent compositions comprise salts. As to claim 35, WO '090 does not teach that the break of step b) occurs along a line of perforation. It is the Examiner's position that it would have been obvious for one having ordinary skill in the art to have made the break in WO '090's rolling process along a perforation because the web is more easily torn in that region, and therefore is less likely to cause an uneven tear in the web.

14. Claims 13, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2 as applied to claims 1-12, 14, 16-19, and 21-48 above, and further in view of Cole et al. (US 6,444,214).

WO '090 lacks a teaching of the specifics of the web material that may be used in its invention. One skilled in the art would have been motivated to look to the prior art to obtain information of specific web materials that may be used in its coating and rolling process. Cole et al. discloses exemplary substrates and wetting solutions, and states that the finished wet wipes of its invention may be packaged in a roll, and specifically that the roll can be coreless. In col. 18, line 40 to col. 19, and col. 23, lines 16-33, Cole et al. teaches that the basesheet may be wet-formed, non-woven, and comprise a water-dispersible binder. In addition, Cole et al. teaches that the web material may be formed from multiple layers/plies (col. 20, lines 60-67). It would have been obvious for one having ordinary skill in the art to have incorporated the substrates and/or wetting solutions taught by Cole et al. in the winding process of WO '090 with the

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expectation of successful results since the references similarly teach rolling wet webs and since WO '090 lacks a teaching of specific web and wetting solution materials that may be used in its process.

15. Claims 3-4, 8-11, are 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 256 950 A1.

As to claims 3-4, the ranges taught by EP '950 overlap the claimed ranges. Overlapping ranges are *prima facie* evidence of obviousness. It would have been obvious to one having ordinary skill in the art to have selected the portion of EP '950's add-on range that corresponds to the claimed range. *In re Malagari*, 184 USPQ 549 (CCPA 1974). Claims 8-11 and 16-17 are rejected for the same reasons discussed above with respect to the WO '090 reference.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Deacon et al. (US 4,601,938) is cited for its teaching of winding a wet web of material having a wetting solution thereon (see col. 7, lines 42-59, and Figure 7).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten Crockford Jolley whose telephone number is 703-306-5461. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

kcj  
April 21, 2003

Kirsten C. Jolley  
Kirsten C. Jolley  
Patent Examiner  
Technology Center 1700